



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,763	11/15/2001	Corey M. Crafton	1533.1940002/MAC/MBT	7167

26111 7590 03/24/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

28/4.

Office Action Summary

Application No.

09/987,763

Applicant(s)

CRAFTON ET AL.

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-73 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:4, classified in class 536, subclass 23.1
- II. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:5, classified in class 536, subclass 23.1
- III. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:6, classified in class 536, subclass 23.1
- IV. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:7, classified in class 536, subclass 23.1
- V. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:8, classified in class 536, subclass 23.1
- VI. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:9, classified in class 536, subclass 23.1
- VII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:10, classified in class 536, subclass 23.1
- VIII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:11, classified in class 536, subclass 23.1
- IX. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:12, classified in class 536, subclass 23.1
- X. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:13, classified in class 536, subclass 23.1
- XI. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:14, classified in class 536, subclass 23.1
- XII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:15, classified in class 536, subclass 23.1
- XIII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:16, classified in class 536, subclass 23.1
- XIV. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:17, classified in class 536, subclass 23.1

Art Unit: 1636

- XV. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:18, classified in class 536, subclass 23.1
- XVI. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:19, classified in class 536, subclass 23.1
- XVII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:20, classified in class 536, subclass 23.1
- XVIII. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:21, classified in class 536, subclass 23.1
- XIX. Claims 1-35, drawn to isolated polynucleotides sequences comprising SEQ ID NO:22, classified in class 536, subclass 23.1
- XX. Claims 39-44, drawn to isolated *Corynebacterium* chromosome comprising SEQ ID NO:1 (pta-gene), classified in class 536, subclass 23.1
- XXI. Claims 46-51, drawn to isolated polynucleotides sequences comprising SEQ ID NO:2 (aceA gene), classified in class 536, subclass 23.1
- XXII. Claims 52-58, drawn to isolated polynucleotides sequences comprising SEQ ID NO:3 (aceB gene), classified in class 536, subclass 23.1
- XXIII. Claims 59-66, drawn to isolated *Corynebacterium* chromosome comprising SEQ ID NO:23, classified in class 536, subclass 23.1
- XXIV. Claims 67-71, drawn to isolated *Corynebacterium* chromosome comprising SEQ ID NO:26 (trc-gene) and SEQ ID NO:28, classified in class 536, subclass 23.1
- XXV. Claims 67-71, drawn to isolated *Corynebacterium* chromosome comprising SEQ ID NO:27 (tac-gene) and SEQ ID NO:28, classified in class 536, subclass 23.1

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXV are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO: 4, SEQ ID NO: 5, SEQ ID NO: 6, SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 9, SEQ ID NO: 10, SEQ ID NO: 11, SEQ ID NO: 12, SEQ ID NO: 13, SEQ ID NO: 14, SEQ ID NO: 15, SEQ ID NO: 16, SEQ ID NO: 17, SEQ ID NO: 18, SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO:23, SEQ ID NO:26, SEQ ID NO: 27 and SEQ ID NO:28 are structurally distinct nucleotide sequences which encodes functionally distinct polypeptides. Thus these inventions are distinct and are of separate uses.

This application contains claims directed to the following patentably distinct species of the claimed invention: (a) aspartokinase, (b) diaminopimelate dehydrogenase, (c) diaminopimelate decarboxylase, (d) dihydrodipicolinate synthetase, (e) dihydrodipicolinate reductase, (f) aspartate beta-semialdehyde dehydrogenase, and (g) pyruvate carboxylase.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 9 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-XXIV or visa versa, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1636

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

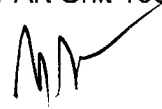
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 571-272-0769. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 571-272-0781.

The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1636

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sumesh Kaushal
Examiner Art Unit 1636

A handwritten signature in black ink, appearing to read 'Jeffrey Fredman', with a stylized, sweeping flourish extending from the end of the name.

JEFFREY FREDMAN
PRIMARY EXAMINER